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AUG 30 2004

In re Application of :
Schurenberg et al. :
Application No. 10/749,746 : ON PETITION
Filed: August 31, 2003 :
Attorney Docket No.: 11389-0037-999:

This is a decision on the "Response to Notice of Omitted Items in a Nonprovisional Application" filed June 3, 2004, requesting in effect, that a Notice of Omitted Item(s) in a Nonprovisional Application ("Notice") mailed May 3, 2004 be withdrawn.

The application was filed on August 31, 2003. However, on May 3, 2004, the Office of Initial Patent Examination mailed the Notice stating that the application had been accorded a filing date of August 31, 2003 but figure 80 as described in the specification appeared to have been omitted.

In response, figure 80 as described in the specification and the present petition were filed on June 3, 2004. The petition states figure 80 was inadvertently omitted. Applicants argues since the specification submitted on August 31, 2003 indicated the present application is a continuation application and incorporated by reference the entire disclosure of a prior application, figure 80 was constructively filed.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission

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as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner neither asserts that the missing page was actually deposited in the PTO on August 31, 2003, with the other application papers nor request a later filing date.

Instead, applicants seek to add the pages of the specification to the present application on the basis that the pages are not new matter. However, no petition is necessary for that purpose. Additional pages of the specification may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP 608.02(a). MPEP 201.06 (c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

In view of the incorporation by reference of the prior application, figure 80 as described in the specification supplied on June 3, 2004, would not constitute new matter if it was part of the original disclosure of the prior application (09/734,336).

If applicants desire that figure 80 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the pages. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the USPTO.

Obviously, in view of the incorporation by reference of the prior application, figure 80 as described in the specification is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of August 31, 2003 using the application papers received in the Office on that date.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.



Charlema R. Grant
Petition Attorney
Office of Petitions